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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,104	11/15/2000	Eiichi Sato	B422-143	9652

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EXAMINER

MOORTHY, ARAVIND K

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 04/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/713,104	Applicant(s) SATO, EIICHI	
	Examiner Aravind K. Moorthy	Art Unit 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6,8-10 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6,8-10 and 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the RCE filed on 27 March 2006.
2. Claims 1, 6, 8-10 and 21-24 are pending in the application.
3. Claims 1, 6, 8-10 and 21-24 have been rejected.
4. Claims 2-5, 7 and 11-20 have been cancelled.

Continued Examination Under 37 CFR 1.114

5. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 27 March 2006 has been entered.

Response to Arguments

6. On page 7, the applicant argues that the limitation of "selecting a method of transferring the received data" is disclosed in FIGS. 5 and 9 and page 15, line 3 to page 17, line 2 of applicant's drawings and specification. The applicant argues that these portions of the specification and drawings disclose discriminating whether or not the received data is confidential and judging whether a public key exists so as to provide a secure transfer path, and, in accordance with such discrimination and/or judgment, selecting in steps S512, S508 and S510 the method to be used for transferring the received data. The applicant argues that specifically, page 15, lines 14-20 of applicant's specification and FIGS. 5 and 9 of applicant's drawings disclose that if it is discriminated that the received data is not confidential, a method of transferring the received data attached with an e-mail is selected in step S512.

The examiner respectfully disagrees. As mentioned above, the applicant states that the specification discloses discriminating whether or not the received data is confidential and judging whether a public key exists so as to provide a secure transfer path, and, in accordance with such discrimination and/or judgment, selecting in steps S512, S508 and S510 the method to be used for transferring the received data. The examiner requests the applicant to specifically point out where in the specification that portion is disclosed. The examiner does not find any disclosure of the above in FIGS. 5 and 9 or page 15, lines 3 to page 17, line 2 of applicant's drawings and specification. Specifically, according to the applicant's drawings step S512 corresponds to "transmit e-mail with received image", S508 corresponds to "encrypt received image", and S510 corresponds to "store received image into memory box". None of the steps listed disclose selecting the method to be used for transferring the received data. As stated above, the applicant argues that page 15, lines 14-20 of applicant's specification and FIGS. 5 and 9 of applicant's drawings disclose that if it is discriminated that the received data is not confidential, a method of transferring the received data attached with an e-mail is selected in step S512. Again, step S512 corresponds to "transmit e-mail with received image". This is not selecting a method of transfer.

On page 8, the applicant argues that the limitation of "controlling means for controlling to transfer the received data" is shown in FIG. 1 of applicant's drawings and described on page 4, lines 15-16 of applicant's specification, which disclose a CPU (101) controlling the functions of the communication apparatus, including transferring of the received data using the selected method.

The examiner respectfully disagrees. The FIG. 1 of the application corresponds to a block diagram showing the configuration of a communication apparatus of the present invention. The figure does not show “controlling means for controlling to transfer the received data”. The applicant points to page 4, lines 15-16 to show disclosure of this limitation. After a review of this section, the examiner fails to see any disclosure. The only thing this section shows is that there is a CPU 101 for controlling the entire apparatus. This does not disclose “control means for controlling to transfer the received data by using the method selecting by said selection means”. The examiner further requests a detailed explanation of the correlation between a CPU 101 for controlling the entire apparatus and “control means for controlling to transfer the received data by using the method selecting by said selection means”.

7. Regarding the prior art, the applicant's arguments with respect to claims 1, 6 and 8-10 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1, 6, 8-10 and 21-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitations “selecting a method of transferring” and “control means for

controlling to transfer the received data by using the method selecting by said selection means” are not enabled by the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 6, 9, 10, 21 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Cornuejols et al U.S. Patent No. 7,020,774 B1.

As to claim 1, Cornuejols et al discloses a communication apparatus for transferring data from a first network to a second network, the apparatus comprising:

first discrimination means for discriminating if the received data is a confidential data [column 16, lines 26-45];

judgment means for judging if the transfer path to the destination of the received data is secure or not [column 19 line 63 to column 20 line 2];

selection means for selecting a method of transferring the received data from a method of transferring the received data attached with E-mail to the terminal, a method of encrypting the received data and transferring the encrypting data attached with E-mail to the terminal or a method of storing the received data in a predetermined memory and transferring information to be used for access to the stored received data attached with E-mail to the terminal to in accordance with

the result of the discrimination by the first discrimination means and the result of the judgment by judgment means [column 49 line 55 to column 50 line 31]; and

control means for controlling to transfer the received data by using the method selected by the selection means [column 49 line 55 to column 50 line 31].

As to claims 6, 21 and 23, Cornuejols et al discloses an apparatus further comprising:

management means for managing encryption information correlated to the terminal [column 32 line 10 to column 33 line 17]; and

second discrimination means for discriminating if the encryption information correlated with the terminal is managed by the management means [column 32 line 10 to column 33 line 17],

wherein the control means controls a method of providing the terminal with the received data in accordance with the discrimination results [column 32 line 10 to column 33 line 17].

As to claim 9, Cornuejols et al discloses a communication method of transferring data from a first network to a second network, the method comprising:

first discrimination step for discriminating if the received data is a confidential data [column 16, lines 26-45];

judgment step of judging if the transfer path to the destination of the received data is secure or not [column 19 line 63 to column 20 line 2];

selection step for selecting a method of transferring the received data from a method of transferring the received data attached with E-mail to the terminal, a method of encrypting the received data and transferring the encrypting data

attached with E-mail to the terminal or a method of storing the received data in a predetermined memory and transferring information to be used for access to the stored received data attached with E-mail to the terminal to in accordance with the result of the discrimination by the first discrimination step and the result of the judgment by judgment step [column 49 line 55 to column 50 line 31]; and

control step of controlling to transfer the received data by using the method selected in the selection step [column 49 line 55 to column 50 line 31].

As to claim 10, Cornuejols et al discloses a computer readable memory medium storing a program of a communication method of transferring data from a first network to a second network, the apparatus comprising:

first discrimination means for discriminating if the received data is a confidential data [column 16, lines 26-45];

judgment step of judging if the terminal of an address of the transfer path to the destination of the received data is secure or not [column 19 line 63 to column 20 line 2];

selection step of selecting a method of transferring the received data from a method of transferring the received data attached with E-mail to the terminal, a method of encrypting the received data and transferring the encrypting data attached with E-mail to the terminal or a method of storing the received data in a predetermined memory and transferring information to be used for access to the stored received data attached with E-mail to the terminal to in accordance with the

result of the discrimination by the first discrimination step and the result of the judgment by judgment step [column 49 line 55 to column 50 line 31]; and control step of controlling to transfer the received data by using the method selected in the selection step [column 49 line 55 to column 50 line 31].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 8, 22 and 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cornuejols et al U.S. Patent No. 7,020,774 B1 as applied to claims 1, 9 and 10 above, and further in view of Perlman U.S. Patent No. 6,363,480 B1.

As to claims 8, 22 and 24, Cornuejols et al does not teach management means for managing the encryption information and an effective period of the encryption information correlated with the terminal. Cornuejols et al does not teach discrimination means for discriminating the effective period of the encryption information and if the encryption information correlated with the terminal which is a destination of the received data is managed by the management means. Cornuejols et al does not teach that the control means controls a method of providing the received data in accordance with the discrimination results.

Perlman teaches management means for managing the encryption information and an effective period of the encryption information correlated with the terminal [column 6 line 58 to column 7 line 8]. Perlman teaches discrimination means for discriminating the effective period

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of the encryption information and if the encryption information correlated with the terminal which is a destination of the received data is managed by the management means [column 6 line 58 to column 7 line 8]. Perlman teaches that the control means controls a method of providing the received data in accordance with the discrimination results [column 6 line 58 to column 7 line 8].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Cornuejols et al so that the destination information in the header would have included encryption information corresponding to the destination was within an effective period. The management system would have determined if the encrypted information correlates with the effective period and if the encrypted information was received by the appropriate destination. The means of providing the information would have been in accordance with the determination of the effective period.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Cornuejols et al by the teaching of Perlman, as described above, because it permits selection of an appropriate decryptability lifetime for specific units of data, such as electronic mail messages. Further, where one or more third party ephemizer systems are used to provide ephemeral keys to encrypt a message, such third party ephemizers may be employed to destroy the ephemeral keys at their expiration times, without burdening the communicating parties with this responsibility [column 4, lines 18-27].

Conclusion


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K. Moorthy whose telephone number is 571-272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aravind K Moorthy 
April 12, 2006

**CHRISTOPHER REVAK
PRIMARY EXAMINER**

 4/12/06